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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM M. KURPLE, ANTHONY F. MAIURO, and
THOMAS BURNS

Appeal 2008-2601
Application 10/803,839
Technology Center 3600

Decided: November 26, 2008

Before WILLIAM F. PATE, III, JENNIFER D. BAHR, and MICHAEL W. O'NEILL, *Administrative Patent Judges*.

O'NEILL, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William M. Kurple, et al. (Appellants) seek our review under 35 U.S.C. § 134 of the final rejection of claims 1-6, 10-16, 20-26, 30-34, 36-46, 48, and 49. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We AFFIRM and denominate our affirmance as a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b).

THE INVENTION

The invention is a self-standing floor sign that allows a user to change the message displayed on the sign. (Specification 3.) The floor sign includes a pair of stationary support panels and at least one moveable message panel. (Specification 5.)

Each panel includes a pair of opposing surfaces ending with an upper (proximal) end and lower (distal) end. The support panels are connected together at each panel's upper end by a pivoting connection, e.g., hinges. Adjacent the upper end of each panel is a runner. The runner extends from one surface of the first support panel to one surface of the second support panel. A moveable panel engages the runner. The moveable panel moves along the runner between a first position where the moveable panel is resting in a generally parallel relationship to a surface of the first support panel to a second position where the moveable panel will rest in a generally parallel relationship to a surface of the second support panel. (Specification 6.)

THE PRIOR ART

The Examiner relies upon the following as evidence of unpatentability:

Appeal 2008-2601
Application 10/803,839

Ericson US 2,208,213 Jul. 16, 1940

THE REJECTION

The following Examiner's rejection is before us for review:

Claims 1-6, 10-16, 20-26, 30-34, 36-46, 48 and 49 are rejected under 35 U.S.C. § 102(b) as being anticipated by Ericson.

ISSUES

The Examiner found Ericson meets the claimed subject matter of the movable panel being movable (or moving) between a first position where the movable panel is parallel to the first support panel's surface and a second position where the movable panel is parallel to the second support panel's surface. The Examiner found Ericson meets this claimed subject matter because Ericson shows in Figure 4 panels 4 parallel to first support panel 7 and in Figure 3 the panels 4 parallel to the surface of second support panel 8. The Examiner concluded that Figure 4 shows the first position and that Figure 3 shows the second position. (Ans. 4.)

The Appellants contend that the Examiner erred in rejecting the claims because Ericson does not describe a movable panel moving to a second position parallel to a second surface of a second support panel. (App. Br. 7-8.) The Appellants support their contention by pointing out that the sheets 4, on which the Examiner reads the claimed movable panels, are enclosed between cover members 7 and 8, on which the Examiner reads the first and second support panels. (Reply Br. 2.) As such, the Appellants

argue the panels 4 in Figure 3 are incapable of moving from a first position to a second position. (*Id.*) The Appellants argue while the same panels 4 shown in Figure 4 are movable, their movement never results in the panels being parallel to what the Examiner has found as the second support surface 8. (*Id.*)

The Appellants argue each independent claim and its dependent claims as a group. As such, we select independent claims 1, 10, 20, 30, and 36 as representative claims for the respective groups argued by the Appellants. Accordingly, dependent claims 2-6, 11-16, 21-26, 31-34, 37-46, 48, and 49 will stand or fall with the independent claim from which they depend.

The issues before us are as follows:

Did the Examiner err in finding that Ericson describes a movable panel movable from a first position wherein the movable panel is generally parallel to the first surface or support panel to a second position wherein the movable panel is generally parallel to the second surface or support panel, as called for in claims 1, 10, and 20?

Did the Examiner err in finding that Ericson describes a step of moving at least one movable panel from a first position wherein the movable panel is generally parallel to the first surface to a second position wherein the movable panel is generally parallel to the second surface, as called for in claim 30?

Did the Examiner err in finding the interrelationship of Ericson's front cover 7 (first support panel), back cover 8 (second support panel), and sheets (movable panel) 4 meets the claimed subject matter of each movable panel

being supported by the second (other) support panel, as called for in claim 36?

FINDINGS OF FACT

We find that the following enumerated findings of fact are supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

1. Ericson describes a display binder 1 having a flexible section 11 and a folding easel 2 incorporated into the front and back covers, 7 and 8 respectively, such that the binder 1 may be folded into a book to facilitate carrying and may easily be erected for display by merely turning back the front cover and unfolding the easel. (Ericson, col. 1, ll. 23-27.) When the easel 2 is unfolded, the easel 2 supports the sheets 4 contained within the binder 1 in an extended relation one above the other. (Ericson, col. 1, ll. 27-31 and Figure 1.)
2. As shown in Figure 3, Ericson's front cover 7 and back covers 8 are generally parallel to each other. In addition, sheets 4 are parallel to the front and back covers. (Ericson, Figure 3.)
3. Easel 2 includes two panels 19 and 20 and a foldable connecting panel section 21. Back cover 8 swings away from panel 19. Such a motion results in the easel 2 extending as shown in Figure 1. Front cover 7 and panel 19 form rigid backs for the binder 1 and back cover 8 serves as a strut to hold front cover 7 and panel 19 in an extended

relationship as also shown in Figure 1. (Ericson, col. 3, ll. 20-39 and Figure 1.)

4. As shown in Figures 1 and 4, when a person desires to erect the binder for display, the person swings front cover 7 back until it rests against the inner edge of the back cover 8 at point 32. The construction of flexible section 11 accommodates the movement of the front cover 7 resting against the inner edge of the back cover 8 at point 32. Next, panel 19 is moved forward and this motion extends foldable connecting panel section 21. Accordingly, front cover 7 and panel 19 serve as backs (support surfaces) for sheets 4 while foldable connecting panel section 21 serves to limit the spread movement of panels 19 and 20. Foldable connecting panel 21 is designed so when the front cover 7 rests against the upper edge of the back cover 8 and the easel 2 is extended, the front cover 7 and the panel 19 are supported in a substantially coplanar relationship. (Ericson, col. 4, ll. 30-60.)
5. While Ericson's Figures 3 and 4 may not depict movement of sheets 4 from a first position to a second position, sheets 4 are movable between a first position wherein they are parallel to front cover 7 and a second position wherein they are parallel to back cover 8. Specifically, with the binder opened, that is, with front cover 7 moved counter-clockwise along the runner and back cover 8 moved clockwise along the runner, from their parallel positions as illustrated in Fig. 3, sheets 4 are movable between a first position in which they are parallel to the front cover (first panel) 7 and a second position in which they are parallel to the back cover (second panel) 8.

6. If front cover 7 is moved counter-clockwise along the runner and back cover 8 moved clockwise along the runner, from their positions as illustrated in Figure 3, such that the outside faces of covers 7 and 8 face one another, sheets 4 can be flipped between a first position parallel to cover 7 and a second position parallel to cover 8.
7. Figure 4 shows movement of the sheets 4 between a first position in which they are parallel to panel 15 and a second position in which they are parallel to panel 19. (Ericson, Figure 4.)
8. Ericson's figure 4 shows sheets 4 rest on panel 19. Panel 19 abuts panel 20. Panel 20 abuts flexible section 11. Flexible section 11 connects back cover 8. As such, the panel 21 and flexible section 11 are in a state of tension while the back cover 8, panel 19, and panel 20 are in a state of compression when Ericson's binder is set up for the displaying of sheets 4 in the coplanar manner as shown in figure 1. (Ericson, col. 4, ll. 67-72.)

PRINCIPLES OF LAW

There must be no difference between the claimed invention and the reference disclosure, as viewed by a person of ordinary skill in the field of the invention. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 1576 (Fed. Cir. 1991). This being said, “[t]he law of anticipation does not require that the reference ‘teach’ what the subject patent teaches. Assuming that a reference is properly ‘prior art,’ it is only necessary that the claims under attack, as construed by the court, ‘read on’ something disclosed in the reference, i.e., all limitations of the claim are found in the reference, or

‘fully met’ by it.” *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 772 (Fed. Cir. 1983).

ANALYSIS

Claims 1, 10, and 20 require that the movable panel is movable along a runner from a first position wherein the movable panel is generally parallel to the first surface or support panel to a second position wherein the movable panel is generally parallel to the second surface or support panel. The panel’s movement starts at a first position where the panel is generally parallel to a first surface or first support panel and ends at a second position where the panel is generally parallel to a second surface or second support panel. The Examiner has found that sheets 4 meet the claimed movable panel. (Ans. 3.) The Examiner has found that back cover 8 meets the second surface of the second support panel. (Ans. 4.)

While Ericson’s Figures 3 and 4 may not depict movement of sheets 4 from a first position to a second position, sheets 4 are movable between a first position wherein they are parallel to front cover member 7 and a second position wherein they are parallel to back cover member 8. (Fact 5.) Specifically, with the binder opened, that is, with front cover (first panel) 7 moved counter-clockwise along the runner and back cover (second panel) 8 moved clockwise along the runner, from their parallel positions as illustrated in Fig. 3, sheets 4 are movable between a first position in which they are parallel to the first panel 7 and a second position in which they are parallel to the second panel 8 (Fact 5), as called for in claims 1 and 20.

As for claim 10, with front cover 7 moved counter-clockwise along the runner and back cover 8 moved clockwise along the runner, from their positions as illustrated in Figure 3, such that the outside faces of covers 7 and 8 face one another, sheets 4 can be flipped between a first position parallel to cover 7 and a second position parallel to cover 8. (Fact 6.) Accordingly, the claimed subject matter of the movable panel being generally parallel to the second support panel after the panel has been moved along the runner from the first support panel is met by Ericson. Moreover, with the cover members 7, 8 so oriented, the binder can be supported on an easel or suspended from above. Consequently, we find that the distal ends of 7 and 8 are adapted for supporting the sign from a support surface, as called for in claim 10.

Claim 30 requires the step of moving one movable panel from a first position where the movable panel is generally parallel to a first surface of one support panel to a second position where the panel is generally parallel to a second surface of one of the support panels. Ericson's figure 4 does not illustrate sheets 4 being moved to a position where the sheets are generally parallel to back cover 8, the structure on which the Examiner reads one of the support panels of claim 30. Instead, the movement of the movable panel 4 terminates at panel 19. However, if panels 15 and 19 are considered the first and second support panels, then Figure 4 shows movement of the sheets 4 between first and second positions as claimed. (Fact 7.) Accordingly, Ericson meets the movement of the panels as claimed.

The Appellants argue Ericson does not meet the claimed subject matter of the movable panel being rotatable to a second position wherein it is supported by the second support panel because sheets 4, on which the

Examiner reads the movable panel, are not supported by back cover 8, on which the Examiner reads the second support panel. (App. Br. 9.)

However, the Appellants' argument presumes that the movable panel has to be *directly* supported by the other support panel. The limitation is not drafted so narrowly in scope. Claim 36 only requires "the movable panel is supported by the other of said support panels." As viewed by a person of ordinary skill in the field of the invention, Ericson's figure 4 shows sheet 4 rests on panel 19. Panel 19 abuts panel 20. Panel 20 abuts flexible section 11. Flexible section 11 connects back cover 8 that the Examiner has found to meet the second or other support panel. When Ericson's device is set up for display of sheets 4 the panel 21 and flexible section 11 are in a state of tension while the back cover 8, panel 19, and panel 20 are in a state of compression. (See Fact 8.) Accordingly, what the Examiner has found to meet the second or other support panel, back cover 8, does support, at least *indirectly*, the sheets 4.

CONCLUSIONS

The Examiner did not err in finding that Ericson describes a movable panel movable from a first position wherein the movable panel is generally parallel to the first surface or support panel to a second position wherein the movable panel is generally parallel to the second surface or support panel, as called for in claims 1, 10, and 20.

The Examiner did not err in finding that Ericson describes a step of moving at least one movable panel from a first position wherein the movable panel is generally parallel to the first surface to a second position wherein

Appeal 2008-2601
Application 10/803,839

the movable panel is generally parallel to the second surface, as called for in claim 30.

The Examiner did not err in finding the interrelationship of Ericson's front cover 7 (first support panel), back cover 8 (second support panel), and sheets (panel) 4 meets the claimed subject matter of each movable panel being supported by the second (other) support panel, as called for in claim 36.

DECISION

The Examiner's decision to reject claims 1-6, 10-16, 20-26, 30-34, 36-46, 48, and 49 is affirmed.

Our rationale in affirming the Examiner's decision differs from or substantially elaborates on that articulated by the Examiner. Accordingly, we denominate our affirmance of the Examiner's decision to reject claims 1-6, 10-16, 20-26, 30-34, 36-46, 48, and 49 as a new ground of rejection pursuant to our authority under 37 C.F.R. § 41.50(b) in order to provide the Appellants with an opportunity to react thereto.

This decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

Appeal 2008-2601
Application 10/803,839

37 C.F.R. § 41.50(b) also provides that the appellant, *WITHIN TWO MONTHS FROM THE DATE OF THE DECISION*, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution.* Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing.* Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED; 37 C.F.R. § 41.50(b)

Appeal 2008-2601
Application 10/803,839

LV:

THOMPSON COBURN, LLP
ONE US BANK PLAZA
SUITE 3500
ST LOUIS, MO 63101